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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,241	01/11/2002	Pascal Thomas	P21836	4804

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GREENBLUM & BERNSTEIN, P.L.C.
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RESTON, VA 20191

EXAMINER

SHRIVER II, JAMES A

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,241

Applicant(s)

THOMAS ET AL. *SW*

Examiner

J. Allen Shriver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-16 and 31-35 is/are allowed.
- 6) ☒ Claim(s) 17, 19-22, 24 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 18, 23, 25, 26 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's submittal of an amendment was received on November 24, 2003, wherein claims 3, 5-7 were amended, claims 1-2 were cancelled and new claims 11-35 were added.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on November 24, 2003 has been considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claim 17, 19-22, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kowatsch (US Patent 4,784,404).** Kowatsch discloses a retaining element (See Figs. 1-2) provided to retain the front of a boot sole on a ski, said retaining element comprising a mounting base (38) including a front zone and a rear zone; a support device (33) having an upper surface to support the boot sole, the support device positioned on the rear zone of the mounting base; a body (12) positioned on the front zone of the mounting base; a jaw (13,14) supported by the body, the jaw having a sole-clamp (15) for vertical retention of the boot sole, the rear zone of the

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mounting base extending rearward of the jaw; the upper surface of the support device and the sole clamp being spaced apart vertically by a distance of between 20 and 28 millimeters (even though the disclosure is silent as to the height distance the upper surface of the support device and the sole-clamp, from the drawings, it is inherent that the height distance shown in Figure 1 discloses a height distance between the upper surface of the support device and the sole-clamp within the claimed range of 20-28 millimeters because the standard ski boot, as set forth in Applicant's submitted copy of the Book of ASTM Standards, ski boot soles can have a maximum height to 19 millimeters (+ or - 1 mm), which would infer that a ski boot having a sole height of 20 millimeters would fit into and operate properly within the retaining element disclosed in Kowatsch.); **[claim 19]** at least one bore (39) in the rear zone of the mounting base for receiving at least one screw for assembling the mounting base with respect to the ski; **[claims 20-21]** wherein the mounting base and the body are formed in a unitary construction; **[claim 22]** wherein the front and rear zones of the mounting base extend along a common longitudinal direction **[claim 24]** wherein the rear zone of the mounting base has two substantially parallel arms (38) that are lower in relation to the front zone; **[claim 27]** wherein the support device (33) is constructed to be movable (See column 5, line 41+).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. **Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kowatsch (US Patent 4,784,404) in view of Stepanek et al. (US Patent 5,501,483).** Kowatsch discloses a retaining element as set forth above, but does not disclose wherein the support device is a support element mounted for rocking movement about a median longitudinal and horizontal axle carried by a support, wherein the support device is a support element movable laterally on both sides of a centered position. Stepanek et al. discloses wherein the support device is a support element (28) mounted for rocking movement about a median longitudinal and horizontal axle carried by a support, wherein the support device is a support element movable laterally on both sides of a centered position (See Fig. 1 and column 3, line 10+). At the time of the invention, it would have been obvious to a person of ordinary skill in this art to provide Kowatsch with a pivoting support element as taught by Stepanek et al. The motivation for doing so would have been to allow the boot to rotate with the ski during a turn.

Allowable Subject Matter

7. Claims 3-16 and 31-35 are allowed over the prior art.
8. The following is an examiner's statement of reasons for allowance: In the Examiner's opinion regarding claim 12, a retaining element to retain a front end of a sole of a ski boot comprising a mounting base having a front zone and rear zone, the front zone being raised with respect to the rear zone by a distance of between 4 and 10 millimeters compared to front and rear zones of a retaining element constructed to receive boots according to standard DIN 7880 Parts I and II, a body positioned on the front zone of the mounting base and a jaw supported by the body, the jaw having a sole clamp for vertical retention of the boot sole, the rear zone of the

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mounting base extending rearward of the jaw, was not anticipated by the prior art, nor would it have been obvious to a person of ordinary skill in this art. During the interview with Applicant's representative, it was explained to the Examiner that the Annual Book of ASTM Standards shows that the dimension of the thickness of the front end of the boot sole is specified as 19 millimeters with a tolerance of 1 millimeter, which is inherently taught in KOWATSCH, which discloses a conventional front retaining element for a ski binding (The copy of the ASTM standards provided by the Applicant has been placed in the file). Therefore, it was stated that a conventional front ski binding (retaining element) that is constructed to receive a ski boot according to the set standards must be consistent with that specification in order to properly fit with conventional ski boot soles. Applicant's retaining element for a front end of the ski boot has a front zone that is raised by between 4 and 10 millimeters with respect to the rear zone of the mounting base, compared to the front and rear zones of a mounting base of a retaining element corresponding to the standards set forth in the ASTM Standards. The benefit of the invention is that it can be used with an alpine ski boot having a thicker sole that is more comfortable for walking when the skier has released his boots from his ski.

Independent claim 31, is original claim 6, which was indicated as containing allowable subject matter in the previous office action, rewritten in independent form.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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9. Claims 18, 23, 25-26 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed November 24, 2003 have been fully considered but they are not persuasive. Applicant argues that independent claim 17, which requires the vertical distance between the upper surface of the boot sole support device and the sole clamp to be between 20 and 28 millimeters, is not anticipated by Kowatsch. As set forth above in the rejection, Examiner disagrees with this argument because convention ski boot soles are configured to have a maximum height of 19 millimeters (+ or – 1 millimeter), which would mean that Kowatsch could accommodate a sole height of 20 millimeters.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Allen Shriver whose telephone number is (703) 308-1224. The examiner can normally be reached on Mon-Thurs 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Johnson can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


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J. Allen Shriver
Examiner
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JAS


BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
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4/16/04